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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,228	10/16/2003	Steven D. Culhane	02-200-US2	9854
34704 7590 05/13/2008 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510				
EXAMINER				
HOEY, ALISSA L				
ART UNIT		PAPER NUMBER		
3765				
MAIL DATE		DELIVERY MODE		
05/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/687,228

**Applicant(s)**

CULHANE, STEVEN D.

**Examiner**

Alissa L. Hoey

**Art Unit**

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The BPAI reversed the Examiner's rejections under 35 USC 102(b) to Kratz (US 4,722,099) and under 35 U.S.C. 112, first paragraph. In view of the BPAI decision rendered on 08/30/07, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final)', or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Technology Center Director has approved of reopening prosecution by signing below:

/KAREN M. YOUNG/

Director, Technology Center 3700

Karen M. Young

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnston (US 6,279,161).

In regard to claims 10-13, Johnston discloses the following:

Claim 10. A garment (1) to be worn by a human being comprising:

a front portion and a rear portion (column 5, lines 40-42);

a pair of arms (300) being joined to said front and rear portions (column 5, lines 40-42);

each of said arms (300) having an outer elbow portion formed from a stretch fabric material (330C) and other portions (10, 20) formed from a non-stretch fabric material (column 3, lines 39-44, 50-53 and 63-65); and

underarm portions (320C) formed from a stretch fabric material (column 3, lines 39-44, 50-53 and 63-65).

Claim 11. A garment according to claim 10, wherein the rear portion has

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at least one portion formed from a stretch fabric material (column 5, lines 41-43: figures 2B-2F).

Claim 12. A garment according to claim 10, wherein the rear portion has first and second side portions and a central portion and wherein each of said first and second side portions is formed from a stretch fabric material (column 5, lines 41-43: figures 2B-2F).

Claim 13. A garment according to claim 12, wherein said central portion (10, 20) is formed from a non-stretch fabric material (column 3, lines 39-44).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Herlihy, Jr. (US 5,631,074).

Johnston provides a garment as described above in claim 10. However, Johnston fails to teach a liner having a stretch fabric material layer and an adjacent stretch film material layer and the liner being breathable and stretchable.

In regard to claim 14, Herlihy, Jr. teaches an athletic garment comprising a liner within the garment (figure 2, liner is layers 14, 16).

In regard to claims 15 and 16, Herlihy, Jr. provides a garment having a liner formed of a breathable waterproof stretch fabric material and an adjacent stretch film material layer next to the stretch fabric material layer (figure 2, identifiers 14, 16: column 4, lines 49-56).

It would have been obvious to have provided the athletic garment of Johnston with the liner of Herlihy, Jr., since the athletic garment of Johnston provided with a dual liner with stretchable film and fabric would provide the athletic garment with superior breathability, water fastness and stretchability keeping the user dryer, cooler, more comfortable during athletic activities.

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Goldsby (US 5,182,812).

Johnston provides an outer garment as described above in claim 10. However, Johnston fails to teach the outer garment having a hood that is detachable and collapsible to the outer garment.

Goldsby provides an outer garment having a hood that is detachable and collapsible to the outer garment (figures 1 and 2, identifier 12) so as to protect the user's head from the elements.

It would have been obvious to have provided the outer garment of Johnston with the removable hood of Goldsby, since the outer garment of Johnston having a detachable and collapsible hood would provide the user with a hood that can protect the wearer's head from the elements and can also be detached and stored when not needed by the wearer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALH  
/Alissa L. Hoey/  
Primary Examiner, Art Unit 3765

/Gary L. Welch/  
Supervisory Patent Examiner, Art Unit 3765